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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,394	09/24/2003	Karlheinz Bartzke	GK-ZEI-3217 / 500343.2022	3961
7590	12/14/2005		EXAMINER	
Gerald H. Kiel, Esq. REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			DINH, JACK	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	SF
	10/669,394	BARTZKE ET AL.	
	Examiner	Art Unit	
	Jack Dinh	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 and 8-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.



**Loha Ben**  
**Primary Examiner**

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 24 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 0204 & 1004.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: DETAILED ACTION.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-3 and 8-16 in the reply filed on 11/07/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 11, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrase "first levers" and "the path of the levers" render the claim indefinite. It is unclear of the quantity of levers are in the "first levers". In addition, "the path of the levers" lacks antecedent basis. Therefore, it is unclear of the configuration being claimed.

Regarding claim 11, the term "preferably" renders the claim indefinite. It is unclear whether the limitations after the term are claimed. In addition, it is unclear of the quantity of the

“plates” and the number of foils attach to each plate. Therefore, it is unclear of the configuration being claimed.

Regarding claim 12, “the stepping motor drive” lacks antecedent basis.

Regarding claim 14, “pair of foils” lacks antecedent basis.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9, 10 and 12-15, are rejected under 35 U.S.C. 102(b) as being unpatentable by Hanada (US Patent 5,400,170).

Regarding claim 1, Hanada (figure 3) is interpreted as disclosing an adjustable pinhole for the illumination beam path of a laser scanning microscope, comprising that the pinhole 2 is defined by foil edges which are adjustable relative to one another.

Regarding claim 2, Hanada (figure 3) is interpreted as further disclosing that wherein at least two foils 1, each with at least one straight edge 2, are arranged relative to one another and/or connected to one another in such a way that their edges describe an L-shape and the L-

shaped connection pieces are arranged on one another in such a way that they define a rhombic or square light passage and are moved relative to one another for adjusting the pinhole (col. 4, lines 1-30).

Regarding claim 3, Hanada (figure 3) is interpreted as further disclosing that the movement direction is the direction of the bisecting line of the angle defined by the L-shape or of another angle lying within the defined angle.

Regarding claim 9, Hanada (figure 2) is interpreted as disclosing that the foils have solid-state joints (see reference 7 of figure 2).

Regarding claim 10, Hanada (figure 3) is interpreted as further disclosing that the solid-state joints which are driven by motor 5 are provided for adjusting the foil edges.

Regarding claim 12, Hanada is interpreted as further disclosing that wherein a referencing of the stepping motor drive is carried out by means of a path measuring system and/or an optical detector for detecting the amount of light passing through the pinhole (col. 2, lines 48-67).

Regarding claim 13, Hanada (figure 2) is interpreted as further disclosing that the pinhole can be closed in such a way that the foils overlap.

Regarding claim 14, Hanada (figure 2) is interpreted as further disclosing that the foils has an offset to prevent collision.

Regarding claim 15, the process for manufacturing an adjustable pinhole comprising the step of producing foil edges defining the pinhole by cutting the foil material in a straight line individually or in composite on at least one side would be inherent from Hanada's figure 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanada (US Patent 5,400,170), as applied to claim 15, in view of Bell et al. (US Patent 5,105,582).

Regarding claim 16, Hanada is interpreted as disclosing all the claimed limitations as described above except that the foil edges are treated, preferably by grinding, subsequent to cutting. Within the same field of endeavor, Bell is interpreted as disclosing the teaching that sharpening can be accomplished by grinding a cutting surface to form sharp edges (col. 3, lines 1-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to grind the cut edges for the purpose of sharpening the edges and improving accuracy.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Dinh whose telephone number is 571-272-2327. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jack Dinh



**Loha Ben**  
**Primary Examiner**

